

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,066,295 to Kozak et al., (hereinafter “Kozak”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below.

Initially, in the rejection, the Examiner merely lists several features without an identification of support in the reference (other than a reference numeral) and without identifying which of the features correspond to which of the rejected claims (1-6). The Examiner also cites the cord connection portion without any reference to a reference numeral in Kozak. Therefore, the Examiner has not indicated how the features of independent claims 1 and 2 and dependent claims 3-6 are disclosed or suggested by the prior art as is required by the MPEP (see MPEP 707.07(d)-IMPROPERLY EXPRESSED REJECTIONS; and 706.02(i)).

Kozak teaches a surgical snare having a conventional electrode post (120) as best shown in Figure 2. The electrode post (120) of Kozak is normal (perpendicular) to the sliding direction of the slider (80) as is shown in Figure 1. Therefore, a connection cord (not shown in Kozak) attached to the electrode post will be led in the same normal direction. Thus, when the surgical snare is manipulated, such as rotated about it's axial axis, the connection cord becomes entwined with the handle portion (64) of the instrument. In other words, Kozak suffers from the disadvantages associated with the prior art as discussed in the

background section of the present invention and to which the present invention is directed to overcome.

In stark contrast, claims 1 and 2 of the present application recite:

*"a cord connection portion is configured to lead the connection cord backwards along an advancing and retreating direction of the slider."*

As discussed throughout the specification, such a configuration solves the problems of the prior art, including Kozak in that "even if the entire handle portion is rotated in a direction of the rotation axis ... the cord 19 is prevented from entwining the handle portion 5." (e.g., see page 16, lines 3-24; see also page 13, lines 4-20).

The Kozak reference does not teach or suggest such a feature. Furthermore, as discussed above, the Examiner does not even recite a portion in Kozak where such a feature is taught. The Examiner merely recites the feature with no support for its teaching in the Kozak reference.

Therefore, a high frequency surgical instrument having at least the features discussed above and as recited in independent claims 1 and 2, is nowhere disclosed in Kozak. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claims 1 and 2 are not anticipated by Kozak. Accordingly, independent claims 1 and 2 patentably distinguish over Kozak and are allowable. Claims 3-6 being dependent upon claim 2, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-6 under 35 U.S.C. § 102(b).

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Lastly, the Applicant respectfully submits that each of dependent claims 3-5 patentably distinguish over the cited reference independently of their base claim.

With regard to claim 3, Kozak teaches a conventional electrode post (120) which is fixed normal to the axial direction of the slider (80). Therefore, Kozak does not teach or suggest an electric connection portion having a connection portion rotating portion.

With regard to claim 4, Kozak teaches the conventional electrode post being normal (perpendicular) to the axial direction of the slider. Therefore, Kozak does not teach or suggest a contact pin provided in parallel with the advancing and retreating direction of the slider.

With regard to claim 5, Kozak teaches a fixed electrode post. Therefore, Kozak does not teach or suggest a conversion plug configured to change a direction of the plug in a direction in parallel to the advancing and retreating direction of the slider.

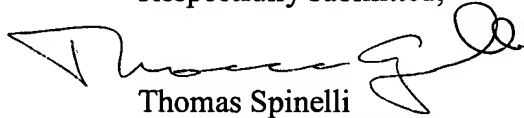
With regard to claim 6, Kozak is silent as to the configuration of a connection cord. Therefore, Kozak certainly does not teach or suggest the connection cord having an L-shaped connector.

Thus, the Applicant respectfully submits that claims 3-6 patentably distinguish over Kozak independently of their base claim (2) and are allowable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be

allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", with a stylized flourish at the end.

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